

## REMARKS

### INTRODUCTION

Claims 1, 3-12 and 14-19 were previously pending and under consideration.

Claims 11-19 are cancelled herein.

Therefore, claims 1 and 3-10 are now pending and under consideration.

Claims 1 and 3-10 stand rejected.

Claims 1 and 7 are amended herein.

No new matter is being presented, and approval and entry are respectfully requested.

### REJECTIONS UNDER 35 USC § 112, FIRST PARAGRAPH

In the Office Action, at pages 2-3, claims 1, 3-10 were rejected under 35 U.S.C. § 112, first paragraph. The rejection proposed that the feature of "non-binding market information" is not supported in the Applicant's specification. Furthermore, the rejection proposes that the feature is a negative limitation requiring clear disclosure.

Applicant respectfully traverses this rejection by pointing to the following parts of the specification that support the non-binding feature. At page 1, lines 7-11, the specification discusses "consumers disclose their interest in or intention to purchase goods on an electronic network to said goods and dealers can buy the right to communicate with the consumers".

From page 6, line 14, to page 7, line 15, the specification states that:

"the posting means 13 posts the market information according to genres, and thus the dealers 3, browsing previously registered genres of market information posted at the posting means 13, search for market information of interest. If, as a result of the information search, a dealer 3 finds a prospective customer who may possibly buy goods, the dealer 3 purchases the market information of such a prospective customer. The personal information acquiring means 14 then acquires the information necessary for accessing the prospective customer (the consumer 2) and notifies it to the dealer 3. In this case, the prior approval demand determining means 14a determines whether or not the consumer's approval is required before the dealer 3 accesses the

consumer 2, ... If the consumer 2 approves the access from the dealer 3, the personal information acquiring means 14 discloses for the first time the personal information acquired from the personal information registering means 12 to the dealer 3. At this time, the accounting means 15 performs an accounting process to **charge the dealer 3 ... for the purchase of the market information**. Based on the acquired personal information the dealer 3 accesses the consumer 2. **If the dealer 3 succeeds in the sale** and the consumer 2 buys goods, the point providing means 17 gives the consumer 2 extra points in reward for the purchase" (emphasis added)

It is clear that a customer's market information is not binding when submitted and a dealer is charged for acquiring the right or ability to communicate with a prospective customer who may or may not make a purchase. See also page 16, lines 5-10, which note that a consumer "can freely enter his/her preferences, "price" which the consumer member desires,...". The Merriam Webster Dictionary indicates that "free" can indicate "not bound ... having no obligations (as to work) or commitments". In other words, a consumer is not bound or obligated to enter a price. See also page 22, lines 4-19, which discuss a consumer entering a variable level of interest in the relevant market information. For example, "the motivation to purchase goods may be expressed by selecting one of four categorized answers, namely, 'almost sure to purchase', 'considering purchase', 'use material for reference' and 'just collecting goods information.'" These parts of the specification reinforce the plain statements above that a consumer is not agreeing in advance to make a purchase; how can a consumer be bound to make a purchase possibly without having agreed to a price and with a possible variable level motivation?

Furthermore, "based on the purchased information, the corporate member makes approaches to the consumer members" (page 12, lines 3-5). The dealer is charged before they contact the consumer; "the corporate member is charged (Step S28) and is permitted to acquire the personal information of the consumer member including information necessary for making approaches (Step S29)." (page 14, lines 9-12).

The rejection characterizes the non-binding feature as a negative limitation. However, the Webster's third international dictionary indicates that an "interest" can be "something that is the object of desire". It is respectfully submitted that information of an "interest" is a positive limitation indicating a consumer's desire. The "non-binding" language merely supplements the positive limitation and further emphasizes that the consumer is advertising an interest and not a

binding offer. Furthermore, whether the feature is characterized as a negative limitation or not, it is clear from the portions of the specification discussed above that the specification provides clear support for non-binding market information.

The rejection also suggests that the specification is not clear because it states "if the consumer member determines to accept the pickup, a pickup 68 then takes place". Directly after the quoted portion, the specification goes on to describe the pickup 68 as "charging ... the corporate member which has picked up the market information. Then, an access method disclosure 68b discloses the method of accessing the consumer member to the corporate member in accordance with the consumer members designation." The referred to "market information" is described earlier as "part of the registered market information" (page 25, lines 9-11). It is clear that the consumer is accepting the dealer's attempt to contact the consumer and the dealer is charged for obtaining a method of accessing the consumer, for example obtaining a fax number. Furthermore, if the posted market information were binding, it would not make sense for a consumer to "accept" a dealer's offer toward the market information interest.

See also the portion quoted above, page 6, line 14, to page 7, line 15, which discusses the dealer contacting a consumer and attempting a sale *after* being charged for and acquiring information allowing the dealer to contact the consumer.

In view of the above, it is respectfully submitted that claims 1, 3-12, and 14-19 are clearly supported by the specification, which provides description of the subject feature sufficient to convey possession of the same.

#### **DELAY AND PATENT TERM ADJUSTMENT**

On July 15, 2002, Applicant filed an RCE with the fees therefor. In response, on March 4, 2004, approximately 1 year and 9 months later, the PTO issued an Office Action, to which this Amendment response. For the purpose of Patent Term Adjustment, Applicant respectfully requests an explanation for the unusually lengthy delay processing the present application.

#### **REJECTIONS UNDER 35 USC § 103**

In the Office Action, at pages 4-5, claims 1, 3-10 were rejected under 35 U.S.C. § 103 as

being unpatentable over Walker '207 in view of Walker '270. This rejection is traversed and reconsideration is requested.

#### INCORRECT CLAIM INTERPRETATION; AND DEALER PURCHASE OF PERSONAL INFORMATION

The rejection is traversed because the rejection improperly reads limitations from the specification into the claims. At page 6, lines 12-14, the rejection states that "therefore, the cited portions of Walker '207 (column 13, lines 1-53, and column 19, lines 55-60) teaches the claims limitation of means ' for acquiring personal information of the consumer necessary for the dealer to access the consumer' as recited in claim 1."

Although the PTO had 1 year and 9 months to respond to Applicant's Amendment, the rejection is directed to an outdated version of the claims. Based on the means-for assumption, the rejection then picks and chooses various isolated segments of the specification and compares them, out of context, to particular portions of Walker '207. The rejection explicitly states that the claims were rejected "based on this interpretation". The rejection also refers back to and relies on the rejections in the previous Office Action (paper no. 22), which also addressed means-for clauses. The rejection is traversed because it misquotes the claims as reciting means-for language and because the rejection uses this misquote to import limitations not recited in the claims. Furthermore, the rejection's interpretation of the specification is respectfully traversed based on the discussion above relating to the rejection under 35 USC § 112, first paragraph.

The rejection remarks that it is unclear whether the dealer is purchasing the market information or the personal information. This conclusion is respectfully traversed and it does not support limiting the claims in view of the specification. While at one point in the last element of claim 1 the word "market" was mistakenly used instead of "personal", the claim clearly recited "a personal information acquiring unit purchasing and acquiring for a dealer ... personal information of the consumer". Correction has been made to change the single instance of "purchased market information" to "purchased personal information". It is respectfully submitted that the entirety of Applicant's prior amendments and remarks were clearly and unambiguously directed to a dealer purchasing personal information, not market information. There is no need for the PTO to refer to the specification to provide a limiting claim construction that is contrary to the explicit non-means language of the claims, and in particular contrary to unambiguous features of

the independent claims other than claim 1; only claim 1 had the mistake mentioned above.

The claims have been amended herein to clarify aspects of the invention such as an exchange with the dealer where the dealer is specifically charged for acquiring or obtaining access to previously withheld personal information of a consumer after viewing the consumer's market information.

Claim 1 recites "posting the non-binding market information ... while withholding from the dealers a portion of the personal information of the consumer necessary for a dealer to identify and contact the consumer about the viewed market information", and "purchasing and acquiring for a dealer, after the dealer has viewed the posted market information, the previously withheld portion of the personal information of the consumer necessary for the dealer to identify" if approved by the consumer.

Withdrawal of the rejection is respectfully requested.

#### **INFORMATION EXTRACTING UNIT AND PICKUP PROCESSING UNIT**

Amended claim 1 recites "an information extracting unit extracting, from the registered personal information, personal information to be disclosed to the dealer when access approval is confirmed; and a pickup processing unit permitting the dealers to pickup the personal information extracted by the information extracting unit". Support for these features may be found at least at Figure 2 and at page 9, lines 4-27 of the specification.

Walker '207 does not disclose an information extracting unit and a pickup processing unit. In Walker, information of a buyer consists of only a name, address, and phone number (column 13, lines 1-53). Withdrawal of the rejection is further respectfully requested.

#### **DEPENDENT CLAIMS**

The dependent claims are deemed patentable due at least to their dependence from allowable independent claims. These claims are also patentable due to their recitation of independently distinguishing features. For example, claim 3 recites "cancel[ing] the purchase of the personal information by the dealer when the consumer does not approve the dealer's access". This feature is not taught or suggested by the prior art. Withdrawal of the rejection of the dependent claims is respectfully requested.

**CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: James T. Strom  
James T. Strom  
Registration No. 48,702

1201 New York Avenue, NW, Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501